

AMENDMENTS TO THE DRAWINGS

1. Attached are formal drawings which include replacement drawing sheets 2/7 through 6/7. These replacement sheets include proposed drawing changes to Figures 2A-2D, 3A-3D, and 4A-4C, and are to replace the original drawing sheets 2-6.

REMARKS

1. In response to the Office Action mailed January 31, 2007, Applicant respectfully requests reconsideration. Claims 1-88 were last presented for examination. In response to a prior restriction requirement, Applicant elected claims 1, 2, 4-12, 14, 20-24, 27-39, 44-48 and 51-56 and claims 3, 13, 15-19, 25, 26, 40-43, 49, 50 and 57-88 were withdrawn from consideration. In the outstanding Office Action, claims 1, 2, 4-12, 14, 20-24, 27-39, 44-48 and 51-56 were rejected. No claims were allowed or objected to. By the foregoing Amendments, claims 1, 2, 4-9, 14, 20-24, 27-28, and 30-31 have been amended, claims 10-12, 29, 32-39, 44-48, and 51-88 have been cancelled, and claims 89-116 have been added. Thus, upon entry of this paper, claims 1, 2, 4-9, 13-28, 30-31, 41-43, 49-50 and 89-116 will be pending in this application. Of these 59 claims, three (3) claims (claims 1, 93 and 108) are independent.
2. Based upon the above Amendments and following Remarks, Applicant respectfully requests that all outstanding rejections be reconsidered and that they be withdrawn.

Election/Restriction

3. As noted, claims 3, 13, 15-19, 25-26, 40-43, 49-50 and 57-88 were previously withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species. Election was made without traverse in Applicant's reply filed October 27, 2006.
4. By the foregoing Amendments, withdrawn claims directed to the invention of Group II, namely claims 57-88, have been cancelled. The other withdrawn claims, which were the subject of species restrictions, remain pending in this application.

Art of Record

5. Applicant acknowledges receipt of form PTO-892 listing additional reference(s) considered by the Examiner.
6. Applicant thanks Examiner for acknowledging receipt of Form PTO/SB/08 indicating that the reference(s) thereon were considering by the Examiner.

New Claims

7. Applicant has added new claims 89-124. Support for the new claims is found in the originally filed specification and drawings. Support for the new independent claim 117 is found in the originally filed specification and drawings in paragraph 43 on pages 8 and 9 of the specification.

Amendments to Drawings

8. Applicant submitted formal drawings attached hereto to replace the informal drawings filed on August 16, 2004. Accordingly, Applicant respectfully submits that the replacement drawings do not constitute new matter. Applicant respectfully requests that the Examiner enter the attached formal drawings.

Amendments to Specification

9. Applicant has made amendments to the specification to address duplicative part numbers shown in the drawings. Angle(s) 214 has been renumbered in the drawings and in the specification as part 215 to distinguish the angle(s) 214 from periosteal pocket 214. Accordingly Applicant requests that the Examiner enter the amendments to the specification.

Rejections of Claims 1-56 Under 35 USC § 112

10. Claims 1-56 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 1, 2, 4-12, 14, 20-24, 27, 28, 30-37, 39, 44-48, and 51-56 to accommodate these rejections. These amendments are believed not to introduce new matter, and their entry is respectfully requested. Claims 29 and 38 have been cancelled, making the rejections of these claims moot. Accordingly, Applicant respectfully requests that these rejections of claims 1, 2, 4-12, 14, 20-24, 27, 28, 30-37, 39, 44-48, and 51-56 be reconsidered and withdrawn.

Claim Rejections of Claims 1 and 29 Under 35 USC §§ 102 and 103

11. Claims 1-2, 4, 7-12, 14, 20, 32-35, 38-39, 44 and 47 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,043,040 to Westerkull (hereinafter "Westerkull"). Applicant has amended independent claims 1 and 32 to overcome these rejections. Based on the above Amendments and the following Remarks, Applicant respectfully requests that these rejections be reconsidered and that they be withdrawn.

12. As noted, independent claim 1 has been rejected under 35 U.S.C. 102(e) as being anticipated by Westerkull. Claim 29 depends from claim 1 and is rejected under 35 U.S.C. 103(a) as being unpatentable over Westerkull. Independent claim 1 has been amended to incorporate the feature(s) of claim 29 to overcome these rejections under Section 102. Claim 29 has been cancelled. With regard to the rejection of claim 29 under Section 103, Applicant respectfully disagrees with the Examiner for the following reasons: (1) the Examiner has based the rejection on a misapprehension of Westerkull '404, (2) there is no teaching or suggestion for the proposed modification of Westerkull '404, and (3) the rejection is based on impermissible hindsight. Applicant now traverses this rejection.

13. The Examiner apparently has misapprehended Westerkull. In the noted rejection, the examiner asserts that due to the need to upgrade components it would have been obvious to make the housing of the Westerkull device in a manner that prevents osseointegration, thereby facilitating removal and replacement with an upgraded device. (See, Office Action, pg. 5.) However, there are a number of supporting presumptions made by the examiner to support this assertion, some of which are incorrect and all of which are not supported by the record of this application.

14. First, there is no disclosure whatsoever in Westerkull that the components of the Westerkull device will need to be upgraded or otherwise replaced. Nor is there any other teaching or suggestion in the art of record that would lead one of ordinary skill at the time of the invention to consider preventing the housing of the Westerkull device from osseointegrating with the skull. Second, even if the components are to be upgraded over time, there is a balance between the replacement intervals and the cost and recovery associated with removing an osseointegrated medical device. For example, if replacement was anticipated to occur annually,

and the trauma and cost of removing the device significant, and there were no alternatives, then perhaps there would be a reasonable inference to draw that there would be a desire to prevent osseointegration. But this is all speculation, these factors are all a matter of degree, and it would be impossible for the examiner to show there are no viable alternatives. This is why such assertions require the examiner to put into the record of an application evidence of such assertions or, alternatively, an affidavit under 37 CFR § 1.104(d)(2). Applicant respectfully requests that the examiner provide either or both if this rejection is to be maintained. Third, there are alternatives to removing the osseointegrated shaft of Westerkull. One example was invented by Westerkull himself, and is described in US Patent No. 7,198,596. This approach is to provide a snap-fit connector between the osseointegrated shaft and the housing. This provides for easy removal of the device when needed such as, for example, to repair or replace with and upgrade. US Patent No. 7,198,596 is attached for the examiner's consideration.

15. Furthermore, Applicant respectfully notes that the Examiner identified an advantage of Applicant's invention being that "electrical components become outdated and need to be replaced, and the prevention of osseointegration of the housing allows for easy replacement of the components." (See, Office Action, pg. 5.) The fact that Applicant's invention provides the noted advantage militates in favor of Applicant's invention because it further shows that the recitations of independent claim 1 provides a completely different system with a completely different structure, operation and purpose.

16. Applicant appreciates that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. However, in this rejection, not only is there absolutely no evidence in the record of this application to support the examiner's proposed modification of Westerkull, the examiner utilized Applicant's own disclosure to provide the rationale for the proposed combination. Thus, the only conclusion that could be reach, based on the record of this application, is that the examiner's unsupported assertions regarding the modification of Westerkull must of come from the Applicant's own disclosure; that is, they were based on impermissible hindsight.

17. Accordingly, Applicant respectfully assert that no legitimate rationale for modifying Westerkull, let alone that it be modified as suggested by the Examiner, has been set forth by the Examiner. For these reasons alone, Applicant respectfully requests that the rejections under

Sections 102 and 103 of independent claim 1, as presently amended, be reconsidered and withdrawn.

Rejection of Claims 32-35, 38-39, 44, and 47 Under 35 USC § 102

18. Independent claim 32 and dependent claims 32-35, 38-39, 44, and 47 have been cancelled, making the rejections of these claims moot.

Dependent Claims

19. Claims 24, 27-31, 48 and 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerkull.

20. Claims 5-6, 21-23, 36-37, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerkull as applied to claims 1, 4, 32, 35 above and further in view of Håkansson (U.S. Patent 6,840,919).

21. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

Conclusion

22. In view of the foregoing, this application should be in condition for allowance. A notice to his effect is respectfully requested.

23. Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application, cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicant reserves the right to pursue such claims in a continuation or divisional application.

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Respectfully submitted,

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